



25 SEP 2007

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In re Application of
BURKE *et al*
U.S. Application No.: 10/567,635
PCT No.: PCT/US2004/025005
Int. Filing Date: 03 August 2004
Priority Date: 08 August 2003
Docket No.: 257122/0092
For: IMPROVED ANTHELMINTIC
FORMULATIONS

DECISION

This is a decision on the papers filed 13 August 2007 which are treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 12 April 2007, a decision dismissing applicants' petition under 37 CFR 1.497(d) and 37 CFR 1.47(a) was mailed. Applicants were given two months to respond with extensions of time available.

On 13 August 2007, a response was filed accompanied by, *inter alia*, a petition under 37 CFR 1.47(a), a two-month extension and fee, a declaration signed by two of the four named inventors, and exhibits 1 - 4.

DISCUSSION

In the papers filed on 12 February 2007, applicants requested to modify the ownership of the subject application to change the inventive entity to Douglas I. Hepler, Joseph M. Lockhart, Ian William Cottrell and Albert Ahn. The international publication recorded the inventors as Michael P. Burke, Vinay Tripathi, Albert Ahn and Ian William Cottrell.

This request was dismissed in a decision dated 12 April 2007.

In the renewed petition, applicants are not attempting to change the inventive entity but are requesting that the subject application be accepted with the signatures of two of the four named inventors. Applicants claim that Vinay Tripathi cannot be located and Michael Burke refuses to cooperate.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof

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that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

The petition fee of \$200.00 was previously paid. Item (1) is complete.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that Mr. Tripathi cannot be located and that Mr. Burke refuses to cooperate. Applicants' burden in showing that an inventor refuses to cooperate, or cannot be located is explained in section 409.03(d) of the MPEP. Several pertinent segments are listed below:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Here, the 37 CFR 1.47(a) applicant provided sufficient proof to show that a diligent effort was made to locate Mr. Tripathi. Petitioner even hired an investigator in

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Ireland to locate Mr. Tripathi. The investigator concluded that there was evidence Mr. Tripathi had moved to India. Other documentary evidence was also provided demonstrating that a diligent effort was made.

With regards to Mr. Burke, a signed letter dated 17 October 2006 was submitted which constitutes a written refusal to cooperate. Moreover, it is clear that Mr. Burke received a copy of the subject application from this letter.

This evidence is sufficient to satisfy item (2) for both inventors.

However, the 37 CFR 1.47(a) applicant failed to satisfy items (3) and (4).

The letter from Network Investigations dated 21 November 2006 lists several addresses for Mr. Tripathi including one where he was living in August 2006. However, the last known address of Mr. Burke is not listed on any documents provided.

As such, item (3) is not yet complete.

Regarding item (4), the 37 CFR 1.47(a) applicant provided a declaration signed by two of the four joint inventors for the nonsigning joint inventors pursuant to section 409.03(a) of the MPEP. However, the declaration does not comply with 37 CFR 1.497(a)(3) in that the citizenship of the nonsigning inventors are not listed. A new declaration is required.

Thus, item (4) is also not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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